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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,748	08/28/2001	Christopher J. Bradford	IN-5475	5758
26922	7590	03/17/2004	EXAMINER	
BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442			BERMAN, SUSAN W	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 03/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/940,748

Applicant(s)

BRADFORD ET AL.

Examiner

Susan W Berman

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 17 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: the new issue is the change from "substantially no" to "no" functional groups in (a22).

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached pages.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Susan W Berman
Primary Examiner
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Continued Examination Under 37 CFR 1.114

A statement that a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application was made in the papers filed 02-13-2004; however, no request for continued examination was included in the submission. Therefore, the papers filed 02-13-2004 have been considered as an amendment after final rejection.

Response to Amendment

Claim 1 has been amended to recite that component (a22) has no functional groups having bonds activatable upon exposure to ultraviolet radiation. This amendment has been considered but fails to obviate the rejections of record.

Lahrman et al teach radiation curable compositions comprising binders not susceptible to radiation curing and providing a non-radiation-induced curing reaction through functional groups, such as hydroxyl, oxirane or isocyanate, may also be added (column 6, lines 43-48). When such binders are used crosslinking agents such as optionally blocked polyisocyanates are added (column 6, lines 48-54). Binders that are not susceptible to radiation-induced curing may be added to the radiation curable clear lacquers to permit an additional curing reaction by reaction with the functional groups (column 6, line 65, to column 7, line 5). See column 5, line 4, to column 7, line 11.

DE 99141 discloses compositions for SMC and BMC coating comprising component (a1) corresponding to instantly claimed component (a1), component (a2) also corresponding to instantly claimed component (a1), and at least one component (a7) corresponding to instantly claimed component (a2) or (a3). Compositions comprising binders, such as polyols, and crosslinking agents, such as blocked di and polyisocyanates, as component (a7) are encompassed within the compositions disclosed by DE '141 because DE '141 teaches adding component (a7) and that (a7) can be binders and/or crosslinking agents.

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Oath/Declaration

The Declaration under 37 CFR 1.132 filed 02-12-2003 is insufficient to overcome the rejection of claims based upon DE '141 as set forth in the last Office action because: The Declaration presents comparative data for a coating composition having an NCO:OH reactive group ratio of 0.9 according to the instantly claimed invention and a coating composition having a ratio of 1.8 according to the example shown in DE '141. The results shown in Table 1 show significant differences in "stone chip rating" and in "% paint loss". However, the data is not persuasive of unexpected results for the following reasons. The data does not establish criticality for the claim 1 limitation "'ratio of NCO groups to the sum of isocyanate-reactive functional groups (a12) and (a21) is less than 1.30". There are numerous variants in the compositions being compared, therefore it is not clear what factor or factors cause the differences in results. The variants are, for example, different urethane acrylates, different polyesters, different additives, different amounts of corresponding components. Furthermore, the example selected from DE '141 does not represent the teaching of DE '141 closest to the instantly claimed invention. The compositions does not contain a component corresponding to (a1) or (a2) taught by DE '141 or a polyisocyanate component(a7). DE '141 teaches a preferred OH:NCO ratio of 0.8:1 to 1.0:1. Furthermore, the data is not commensurate in scope with the instant claims. The examiner is not able to identify the components set forth in the example according to the invention with the components set forth in the instant claims. What are the isocyanate-reactive groups in the "radiation curable component" representing (a1)? What are the isocyanate-reactive functional groups in the "Polyester I" representing (a2)? Which component corresponds to component (a3) comprising at least 2.0 isocyanate groups in the claims? The composition according to the invention contains various fillers, a catalyst and a photoinitiator not recited in the claims. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. In view of the foregoing, when all of the

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evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman
Primary Examiner
Art Unit 1711

SB
March 5, 2004